

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Hall et. al.

SERIAL NO.: 10/696274

ART UNIT: 3625

FILED: 10/29/2003

EXAMINER: Allen, William

TITLE: Interface for Conducting the Closing of a Real
 Estate Sale Over a Computerized Network

ATTORNEY DOCKET NO.: ICLS 1001-3

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Assistant Commissioner For Patents

Washington, D.C. 20231

Amendment

Sir:

This paper is in response to the Final Office Action mailed 12/23/2008 in regard to the above-identified patent application. Claims 17-32 and Claims 34-36 are pending in this case. A separate sheet showing the status of all claims, in accordance with C.F.R. 121 is enclosed.

Remarks

Claims 17, 19-32, and 34-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over Broerman (US20040054606) in view of Walker et al. (US 5794207) in view of Mini et al. (US 6684196B1) and further in view of Ryan et al. (US 6684189B1). Claim 18 is rejected under 35 U.S.C. 103(a) as being

unpatentable over Broerman in view of Walker, in view of Mini in view of Ryan and further in view of Davis (US 6219423).

Claim 23 recited subject matter that may result in allowance if claim 23 is rewritten in independent form and to positively recited the system's ability to classify the closing condition into active and passive categories.

Dependent claim 23 has been rewritten with independent claim 17 herein to conform to the Examiner's suggestion. If entered, the Applicants respectfully assert that all claims now pending are in a condition for allowance.

In the alternative, the Applicants respectfully point out that the multiplicity of references that must be combined in order for the Examiner to reject the claims herein, is in itself evidence of unobviousness. In rejecting claims 17, 19-32, and 34-36 used four references and in rejecting claim 18 the Examiner used five references. Further, the references cited by the Examiner do not contain any suggestion (express or implied) that they be combined, or that they be combined in the manner suggested by the Examiner. In 2007, the U.S. Supreme Court held that an invention should not be held obvious over several prior art references unless there is a suggestion or motivation, or teaching that the references can or should be combined. (*KSR v. Teleflex* (2007)). Moreover, *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991) states:

"When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed.Cir.1985). "

'Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.' " In re Bond, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed.Cir.1990) (quoting Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed.Cir.1986)).

The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention. As in all determinations under 35 U.S.C. Sec. 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. Interconnect Planning, 774 F.2d at 1143, 227 USPQ at 551. The references themselves must provide some teaching whereby the applicant's combination would have been obvious." [Emphasis added]

Finally, even if the references could be combined in the manner suggested by the Examiner, the references would produce an inoperative combination. For example, Walker states that "Anonymity is another advantage of the present invention [and that the present invention maintains anonymity] through the use of identification numbers" [Walker, col. 10, lines 1-7). It will be understood that a real estate contract must identify a buyer against whom the contract can be enforced. The alternative is for the "Principal," the buyer who wishes to remain anonymous, to purchase the property through a nominee. There are two basic structures for nominee transactions. In one, the nominee enters into a contract to buy the property and then assigns the contract to the Principal, and the Principal, not the nominee, closes on the purchase ("pre-closing assignment"). With the other structure, the nominee takes title to the property and later conveys it to the Principal ("post closing transfer"). In either case, Walker does not disclose or suggest authenticating Principles or nominees against whom a legal real estate contract may be enforced. Walker merely

discusses a "3rd party administrator" as a trusted arbitrator but not as a nominee acting on behalf of the Principle against whom a contract may be enforced. Therefore, Walker cannot be legally combined with Broerman. Therefore, the Applicants respectfully assert that all claims now pending are in a condition for allowance.

In the alternative, the Applicants request that the Examiner withdraw the Final Office action status. The Examiner states that the Applicants' amendments necessitated the new grounds of rejection and accordingly the action was made final. However, the Applicants respectfully point out that the amendments were made at the Examiner's suggestion as described in the telephone interview summary submitted with the amendments; and, that the Examiner did not dispute or otherwise clarify that summary in the present office action. Accordingly, the Applicants request that the Examiner withdraw the pending final office action.

Respectfully submitted,

/Kevin P. Correll/

February 17, 2009

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Date

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